REMARKS

By this amendment, Applicants amend claims 1, 5-8, and 12, and add new claims 15-17. Claims 1-17 are now pending.

In the October 26, 2007 Final Office Action, the Examiner rejected claims 1, 6, 7, 10, and 12 under 35 U.S.C. § 112, first paragraph; rejected claims 1-7 and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,237,114 to Wookey et al. ("*Wookey*"); rejected claims 8-11 under 35 U.S.C. § 103(a) as being unpatentable over *Wookey* in view of U.S. Published Patent Application No. 2002/0147850 to Richards et al. ("*Richards*") and U.S. Published Patent Application No. 2002/0156629 to Carberry et al. ("*Carberry*"); rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Wookey* in view of U.S. Published Patent Application No. 2001/0056379 to Fujinaga et al. ("*Fujinaga*"); and rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Wookey* in view of U.S. Published Patent Application No. 2002/0099563 to Adendorff ("*Adendorff*"). Applicants respectfully traverse each of the Examiner's rejections.

I. Rejection of Claims 1, 6, 7, 10, and 12 under 35 U.S.C. § 112, first paragraph

Applicant respectfully traverses the rejection of claims 1, 6, 7, 10, and 12 under 35 U.S.C § 112, first paragraph for allegedly failing to comply with the written description requirement. The Examiner alleges the claims "contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (Office Action, page 2, ¶¶ 4-5).

Applicant notes that "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude <u>that the inventor had possession of the claimed invention</u>," (MPEP § 2163, emphasis added). Furthermore, "[i]t is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." *Id.*

The Examiner first alleged that the phrase "semantically grouped solution identification rules" as recited in claims 1, 7, and 12, fails to comply with the written description requirement. However, examples of this feature are clearly provided in Applicant's disclosure, such as, for example, in ¶ [052] of the specification. Therefore, use of the term "semantically grouped solution identification rules," in view of the specification as a whole, would lead one of ordinary skill in the art to conclude that the inventor had possession of the claimed invention.

The Examiner next alleges that the phrase, "wherein the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module operating for the main system," recited in claims 6 and similar recitations of claim 12, fails to comply with the written description requirement. (Final Office Action, page 3). Applicants have amended claims 6 and 12 to recite "solution identification rules" instead of "solutions," and assert that the phrase "wherein the service system returns solution identification rules that solve the problem indirectly by being further knowledge representations for a further inference module operating for the main system" complies with the written description requirement.

The Examiner last alleges that the phrase "allows analysis by an expert system in the further computer," recited in claim 10, fails to comply with the written description requirement. The Examiner argues that a particular type of expert system must be disclosed (Final Office Action, page 4). Applicant disagrees, and notes that there is no such requirement in 35 U.S.C § 112, first paragraph.

Therefore, Applicant submits that in view of the specification, one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Accordingly, for at least the above reasons, the Examiner should withdraw the rejection of claims 1, 6, 7, 10, and 12 under 35 U.S.C § 112, first paragraph.

II.   **Rejection of claims 1-7 and 12 under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claim 1-7 and 12 under 35 U.S.C. § 102(b) as being anticipated by *Wookey*.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *See also* M.P.E.P. § 2131. In this application, *Wookey* does not disclose each and every element of the claims.

Independent claim 1 recites "a computer system" including a "knowledge module to receive the knowledge representations, generate solution identification rules comprising computer instructions to automatically solve the problem, group sets of the solution identification rules semantically, and store the knowledge representations with the sets of semantically grouped solution identification rules." *Wookey* fails to disclose at least the claimed "solution identification rules."

Wookey discloses that "[c]omputer system 100 receives incoming diagnostic data from monitored system 102." (*Wookey*, col. 3, lines 55-56). "The diagnostic data is collected over a particular time period, so the host state represents the state of the monitored machine over that particular time period." (*Id.* at col. 8, lines 62-64). "Once host states have been created, the data can be analyzed for the presence of alerts." (*Id.* at col. 11, lines 30-31). Alerts are available, and "[o]nce the alerts have been defined and stored in alert types database 243, the alerts have to be run against the host states." (*Id.* at col. 14, lines 66-67). Furthermore, "known problems and resolutions are stored in a systems resolution database." (*Id.* at col. 17, lines 9-10). This systems resolution database includes textual information that "describes the problem and appropriate items to check for in resolving the problem and provides any known resolutions to the problem, such as software patches." (*Id.* at col. 19, lines 46-49). Finally, "[i]f a patch exists for the problem, then the patch or other solution is automatically registered with the system to send a copy of the patch to the customer." (*Id.* at col. 19, lines 53-55).

However, *Wookey's* textual information retrieved from the system resolution data does not constitute the claimed "solution identification rules" because *Wookey's* textual

information does not "compris[e] <u>computer instructions</u> to automatically solve the

problem," as required by claim 1 (emphasis added). Instead, *Wookey's* textual

information provides "an indication of the solution [which] may include a <u>special field</u>

<u>that indicates whether or not there is a patch for this particular problem</u>." (*Wookey*, col.

19, lines 49-51, emphasis added). This special field does not constitute the claimed

"computer instruction." *Wookey's* system then may retrieve the patch based on the

special field, and send the patch to the user (*Id.* at lines 52-54). Therefore, sending the

patch to the user is not carried out by the textual information. Accordingly, *Wookey's*

textual information does not constitute the claimed "solution identification rules," and

Wookey fails to anticipate claim 1.

Independent claims 7 and 12, while of different scope than independent claim 1,

comprise similar recitations as independent claim 1. Accordingly, *Wookey* fails to

anticipate claims 7 and 12 for at least the reasons discussed previously.

Claims 2-6 depend from independent claim 1. Accordingly, *Wookey* fails to

anticipate claims 2-6 at least due to their dependence.

III.   Rejection of Claims 8-11 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 8-11 under 35 U.S.C.

§ 103(a) as being unpatentable over *Wookey* in view of *Richards* and *Carberry*.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear

articulation of the reason(s) why the claimed invention would have been obvious. Such

an analysis should be made explicit and cannot be premised upon mere conclusory

statements. *See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007).* "A conclusion of

obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145.* Furthermore, "[t]he mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. §2143.01(III), internal citation omitted.* Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious." *M.P.E.P. § 2141.02(I),* internal citations omitted (emphasis in original). In this application, a *prima facie* case of obviousness has not been established for at least the reason that the Examiner has not clearly articulated a reason why one of ordinary skill in the art would find the claimed combination obvious in view of the cited references.

Claims 8-11 depend from claim 7, and require all recitations therein. As discussed above, *Wookey* does not teach or suggest each and every element of independent claim 7, from which claims 8-11 depend.

Richards and *Carberry* fail to cure the deficiencies of *Wookey.* That is, *Richards* and *Carberry* fail to teach or suggest "generating solution identification rules comprising computer instructions to automatically solve the problem," as recited by independent claim 7. Moreover, the Examiner has not clearly articulated a reason why the claimed combination would be obvious to one of ordinary skill in view of the applied references. Accordingly, the Examiner has not demonstrated that claims 8-11 are obvious in view of *Wookey, Richards,* and *Carberry,* taken alone or together.

IV.   Rejection of Claim 13 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Wookey* in view of *Fujinaga*. Claims 13 depends from claim 12, and requires all recitations therein. As discussed above, *Wookey* does not teach or suggest each and every element of independent claim 7, from which claim 13 depends.

Fujinaga fails to cure the deficiencies of *Wookey*. *Fujinaga* fails to teach or suggest "the solution identification rules comprise computer instructions to automatically solve the problem," as recited by claim 12. Moreover, the Examiner has not clearly articulated a reason why the claimed combination would be obvious to one of ordinary skill in view of the applied references. Accordingly, the Examiner has not demonstrated that claim 13 is obvious in view of *Wookey* and *Fujinaga*, taken alone or together.

V.   Rejection of Claim 14 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Wookey* in view of *Adendorff*. Claims 14 depends from claim 12, and requires all recitations therein. As discussed above, *Wookey* does not teach or suggest each and every element of independent claim 7, from which claim 14 depends. Accordingly, *Wookey* fails to render obvious claim 13.

Adendorff fails to cure the deficiencies of *Wookey*. *Adendorff* fails to teach or suggest "the solution identification rules comprise computer instructions to automatically solve the problem," as recited by claim 12. Moreover, the Examiner has not clearly articulated a reason why the claimed combination would be obvious to one of ordinary

skill in view of the applied references. Accordingly, the Examiner has not demonstrated

that claim 14 is obvious in view of *Wookey* and *Adendorff*, taken alone or together.

V. New Claims 15-17

New claims 15-17 depend from one of independent claims 1, 7, and 12.

Accordingly new claims 15-17 are allowable over the cited references at least due to

their dependence.

VII. CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration of this

application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

<div align="center">Respectfully submitted,

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Dated: October 31, 2007   By:_____

C. Gregory Gramenopoulos
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